



AUG 06 2007

Doc Code: AP.PRE.REQ

PTO/SB/33 (07/05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

IVT.0034US

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Signature

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Stephanie Petreas

Application Number

10/690,265

Filed

October 21, 2003

First Named Inventor

Dominik J. Schmidt

Art Unit

2617

Examiner

Kiet M. Doan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 42,117

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

Mark J. Rozman

Typed or printed name

512-418-9944

Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: DOMINIK J. SCHMIDT

Serial No.: 10/690,265

Filed: October 21, 2003

For: WIRELESS SECURITY

§ Group Art Unit: 2617

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Examiner: Kiet M. Doan

Atty. Dkt. No.: IVT.0034US

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant seeks pre-appeal review of the rejections of claims 1-4, 6-7 and 12-17. It is respectfully submitted that the rejections to pending claims 1-4, 6-7 and 12-17 are clearly erroneous and the burden of an appeal should be avoided.

Pending claims 1-3, 6-7 and 12-15 stand rejected under 35 U.S.C. §103(a) over U.S. Publication No. 2003/0125073 (Tsai) in view of U.S. Patent No. 6,240,079 (Hämäläinen). As to claim 1, this rejection is clearly erroneous because there is no reason for an ordinarily skilled artisan to combine these references to obtain the claimed subject matter. In this regard, neither reference anywhere teaches or suggests the recited comparison of SIM data with a local copy of an authorized user data file in a base station and granting access based thereon (or indicating an access failure). Still further, the cited references nowhere teach or suggest that data transmission remains within limits of a desired level of service via dynamically adjusted time slots and at least one short-range wireless medium. As such, the proposed combination falls far short of teaching or suggesting the recited subject matter, and one of ordinary skill would have no reason to make the combination. Accordingly, the rejection is clearly erroneous.

8/3/07
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Stephanie Petreas

As to the first missing element, the Examiner relies on Tsai for teaching of the recited comparison and granting of access or indicating an access failure. Specifically, the Examiner refers to paragraphs 24-26, 30 and 36 of Tsai. Yet nothing in these paragraphs or anywhere else in Tsai mentions either presence of “a local copy of an authorized user data file” in a base station or “indicating an access failure” if a comparison doesn’t indicate a match. This is not surprising, as Tsai is not directed to security mechanisms; it is instead concerned with avoiding paging loss by selection of a suitable cell. Look carefully at the cited portions of Tsai: all that can be gathered is that a mobile station sends a directory number of a SIM card to a base station (“Using the information of the directory number..., the mobile phone 100 can access the services provided by the mobile network” Tsai, ¶24). Nothing however is mentioned what the base station does with this information. As such, Tsai utterly fails to teach or suggest that contended by the Examiner.

Still further, the Examiner concedes that Tsai does not teach the recited dynamic time slot adjusting. Instead, the Examiner relies on Hämäläinen for a teaching of dynamic adjusting of time slots. However, Hämäläinen does not teach or suggest performing data transmission using both dynamically adjusted time slots and at least one short-range wireless medium. Nor does Tsai. In this regard, while the Examiner notes that Tsai teaches that two different mobile networks can be of different protocols, nothing in Tsai anywhere teaches or suggests that time slots are *dynamically adjusted during a single data transmission* occurring on both a wireless medium and a short-range radio medium as set forth in claim 1. Instead, Tsai merely teaches that a mobile station can *stand by* for two networks. Thus, the claim recites subject matter that is more than a predictable use of prior art elements, and the rejection is thus clearly erroneous. *KSR Int’l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007).

The rejection of claim 1 over the proposed combination is further improper, as there is no legally sufficient motivation to combine the references. In this regard, all that the Examiner states is that it would have been obvious to modify Tsai and Hämäläinen, then the Examiner simply recites the subject matter of claim 1. Final Office Action, pp. 3-4. This alleged motivation is conclusory and lacks a legally sufficient basis for the proposed combination. *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2001). Even further, it is apparent that the proposed combination is nothing more than hindsight-based reconstruction, in contravention of well established Federal Circuit precedent. *E.g., In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed. Cir.

2000). Accordingly, the rejection of claim 1 and its dependent claims is clearly erroneous. For at least these reasons claim 1 and the claims depending therefrom are patentable over the proposed combination.

Independent claim 12 and claims 13-15 depending therefrom stand rejected under 35 U.S.C. § 103(a) over Tsai and Hämäläinen. However, as to this independent claim, the Examiner appears to contend that Tsai, standing by itself, teaches the recited subject matter. This is clearly not the case, as Tsai nowhere teaches or suggests multiple transceivers in its mobile station. As such, nothing in Tsai can anywhere teach or suggest instructing such multiple transceivers to communicate only via a common wireless medium. Furthermore, in addition to the lack of multiple transceivers for two different wireless media, there is no teaching or suggestion that communication by these two (non-existent) transceivers occurs through the mobile station only via a common wireless medium. Instead, in Tsai communication occurs with a first wireless network or a second wireless network: there is no common wireless medium. Nor does Hämäläinen add anything in regard to the subject matter of claim 12 as apparently conceded by the Examiner. Accordingly, for at least these reasons the rejection of claim 12 and the claims depending therefrom is clearly erroneous.

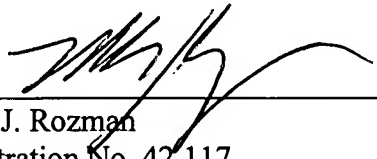
It is noted that the Examiner provides *no* basis in the Office Action for the rejection of claims 16 or 17. This non-existent rejection is thus clearly erroneous.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504.

Respectfully submitted,

Date: _____

8/3/07



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